

SUMMARY

The above Amendment and following Remarks are responsive to the points raised in the June 18, 2003 Office Action. In the Office Action, claims 1-15 and 40-44 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-3 and 8-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Headrick in view of Fehr, Hellström et al, and Snyder. Claims 4-7 and 40-44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Headrick in view of Fehr, Hellström et al, and Snyder and further in view of Taber. Claims 47 and 48 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Headrick in view of Fehr, Hellström et al, and Kurtz. Upon entry of this Amendment, claims 1 and 2 will have been amended to correct minor informalities, claims 16-39 will have been withdrawn from further consideration by the Examiner, and claims 1-15, 40-44, 47, and 48 will be pending in this application. Entry and consideration of this Amendment are respectfully requested.

REMARKS

35 U.S.C. § 112, second paragraph:

Claims 1-15 and 40-44 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has inserted a in place of ~~the~~ in claim 1, line 9. Applicant believes this amendment overcomes 35 U.S.C. § 112, second paragraph rejection and requests removal thereof.

Claim 2 has been amended to correct a minor informality.

REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 1-3 and 8-15 were rejected under 35 U.S.C. § 103(a) as being obvious over Headrick in view of Fehr, Hellström et al., and Snyder. Claims 4-7 and 40-44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Headrick in view of Fehr, Hellström et al., and Snyder and further in view of Taber. Claims 47 and 48 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Headrick in view of Fehr, Hellström et al., and Kurtz. Applicant traverses these rejections.

The Examiner has failed to establish a prima facie case of obviousness as detailed in MPEP § 706.01(j):

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

A prima facie case of obviousness has not been established because there is no suggestion or motivation to combine the reference. Furthermore, all the claim limitations are not disclosed or suggested by any combination of Headrick, Fehr, Hellström et al., Snyder, Taber and Kurtz.

The Examiner has made final the rejections of the claims based upon Headrick, Fehr, Hellström et al., Snyder, Taber, and/or Kurtz in response to the Applicant's amendment and response by transposing the original rejections based upon Fehr so that they are now based upon a proposed combination of Headrick in view of Fehr, Hellström et al., Snyder, Taber, and/or

Kurtz. The Examiner asserts that the rationale to modify and/or combine the prior art references may be reasoned from knowledge generally available to one of ordinary skill in the art and that since "the applicant has failed to address the reasoning/rationale supplied by the Examiner as to why the modification would have been obvious, the applicants' arguments are not persuasive." Applicant respectfully disagrees with this assertion. Specifically, Applicant refers the Examiner to the remarks filed in the Amendment and Response filed on April 1, 2003, beginning on page 6 and continuing to page 9, where the Applicant provides evidence of why the modification and/or combination would not have been obvious and why Fehr and Headrick cannot be combined:

Fehr discloses a framing extrusion having a specific profile. The profile is used around the entire perimeter of the door opening (i.e. 15, 16, 17 and 19). In particular, FIG. 3 shows the profile used as vertical jambs 17, 19, and FIG. 4 shows the profile used as a header 16 and a sill 15.

Independent claim 1 of the present application recites an entryway system including a threshold member joined to a frame. An end cap corner key is positioned between the frame and the threshold member. Fehr does not teach or suggest an end cap positioned between the sill 15 and a frame. The Examiner relies upon the combination of Headrick and Fehr to show the recited limitation.

Applicants respectfully submit that neither Fehr nor Headrick provide the teaching or suggestion to modify the profiles of Fehr to include the end cap of Headrick. Fehr specifically states the profiles are standardized, and thereby can be mitered at their ends and joined together by fusion welding. . . . Column 8, lines 57-62. Because the profiles are standardized, the end pieces correspondingly match one another, and when mitered provide a seal. There is no teaching in Fehr to modify the Fehr profile to include the Headrick end cap.

There is also no teaching in Headrick to modify the Fehr profile to include the Headrick end cap. In particular, Headrick teaches a sill and end cap assembly. The assembly fits between vertical jambs 52 of a door frame. As shown in FIG. 4, "[a] dado 61 is formed in the bottom of the jamb 52 to accommodate the end cap 36, which protrudes slightly beyond the end of the assembly 11. . . ."

Column 6, lines 46-50.

Because of the standardized profile of Fehr, incorporating the Headrick end piece would require significant modifications in the vertical jamb profiles. Modifying the vertical jamb profiles of Fehr to include the end caps would jeopardize the structural integrity of the profile's web structure. (See Fehr, column 8, lines 47-53, stating that the profiles includes a substantial amount of structural reinforcing vertical web members and horizontal web members, so as to provide the necessary rigidity as a framing section.) The asserted combination would render the Fehr profile unsatisfactory for its intended use.

For at least these reasons, Applicants respectfully submit that a *prima facie* case of obviousness to modify the profiles of Fehr to include the end cap of Headrick is lacking. Applicants therefore submit that independent claim 1, and dependent claims 2, 3, and 8-13, are patentable.

Applicant specifically addressed the reasoning/rationale supplied by Examiner and specifically detailed why the proposed combination of Fehr and Headrick does not establish a *prima facie* case of obviousness. Applicant noted that Fehr provides a form fit, mitered seal joined together by fusion welding and that Headrick provides an end cap assembly, which can arguably incorporate a seal, but only a seal that can accommodate the end cap in the bottom of the jamb that protrudes slightly beyond the end of the assembly. The form fitting seal of Fehr cannot accommodate the protrusion of Headrick without modification, which is not shown in either Fehr or Headrick. Additionally, the modification that would be required to fit the end cap assembly of Headrick would render Fehr unsatisfactory for its intended purpose, which is explicitly prohibited under MPEP 2143.01. Since the Examiner has not provided any teaching or suggestion in the prior art to combine Fehr or Headrick or that such a combination would result in the claimed entryway system, a *prima facie* case of obviousness has not been established and a final rejection should not have been issued.

The burden of establishing a *prima facie* case of obviousness is initially placed on the Examiner and shifts to the Applicant once a case has been established. After the initial assertion

of a prima facie case of obviousness, if the Applicant then provides evidence that a prima facie case of obviousness does not exist, the burden to prove the existence of a prima facie case of obviousness shifts back to the Examiner. Here, since the Applicant provided evidence that a prima facie case does not exist in the April 1, 2003 Amendment and Response, the burden shifted back to the Examiner to establish that a prima facie case of obviousness does exist. Since the Examiner has failed to provide a reasonable explanation of how the mitered seal of Fehr could accommodate the protruding end cap of Headrick without rendering Fehr unsatisfactory for its intended purpose, the Examiner has failed to meet his burden of establishing that a prima facie case of obviousness in fact exists. Thus, since the Examiner has failed to meet his burden of prima facie case of obviousness, the conversion of the rejections under 103(a) to final rejections is improper and the rejections should be withdrawn as moot.

With respect to claim 40, the Examiner avers that utilizing the economical method of depositing additional material onto a gasket as purportedly taught in Taber would motivate one of ordinary skill in the art to place a seal between the tank in the groove of the end cap 36 in Headrick. Applicant is unable to find any teaching whatsoever in Taber or Headrick to support the assertions forwarded by the Examiner. Specifically, Headrick appears to teach away from sealing between the end cap and frame as pointed out in the Applicant's April 4, 2003 Amendment and Response and Taber does not appear to provide any reasoning whatsoever to motivate one to place this seal therein. Accordingly, the Applicant avers that the rejections applied to claim 40 are improper and should be withdrawn as moot.

Accordingly, the independent claims, as amended, are allowable and the dependent claims are allowable for the same reasons as the independent claims from which they depend.

Applicant further avers that the final rejections are improper as applied and request an early notice of allowance in accordance with the discussion herein.

CONCLUSION

Claims 1-15, 40-44, 47, and 48 are now believed to be allowable and an early notice to such effect is earnestly solicited. Should the Examiner have any questions or comments regarding the foregoing Amendment and response, he is invited and urged to telephone the undersigned attorney.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees that may be required for the timely consideration of this Amendment Under 37 C.F.R. § 1.116 under 37 C.F.R. §§ 1.16 and 1.17, or credit any overpayment to Deposit Account No. 09-0528.

Respectfully Submitted,

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